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BURR & BROWN PO BOX 7068 SYRACUSE, NY 13261-7068				DEMILLE, DANTON D
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/935,297

Filing Date: August 22, 2001

Appellant(s): LACEY, DWAYNE

 **MAILED**

NOV 03 2005

Kevin Brown
For Appellant

Group 3700

EXAMINER'S ANSWER

This is in response to the appeal brief filed 27 December 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Evidence Relied Upon*

6,450,980	Robbins et al.	9-2002
5,421,799	Rabin et al.	6-1995
3,585,990	Blachly	6-1971
5,611,771	Taylor	3-1997
2,113,444	Erickson	4-1938
836,217	Rowe	11-1906
AU134633	Lacey	8-1998

(9) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4 and 6-33 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Robbins '980 in view of Rabin '799 or Blachly '990.

Robbins teaches the same basic invention as appellant's. Robbins teaches a head massaging device comprising a plurality of resilient fingers having the head receiving space and opening claimed. As clearly shown in figure 1 the ends of the resilient fingers taper inwardly toward the central longitudinal axis of the device forming an opening that is smaller in circumference than the circumference of the fingers to the left of the opening. Figure 10 also exemplifies this shape. When the device is pressed onto the head, the ends of the fingers would contact the head first and as the fingers expand to encompass the head of the user the fingers would apply pressure to and thus massage the head. Because of the circumference of the opening is smaller than the circumference of the larger head receiving space and the ends of the fingers massaging the head of the user the Robbins device comprehends the structure of the plurality of fingers as claimed.

The only difference between Robins and the claimed invention is the provision of adding a vibrator to the device. There appears to be no unobviousness to further enhance the massage therapy by applying a vibration massage to the scalp of the patient.

Rabin's device teaches a plurality of resilient fingers 12 defining a head receiving space therebetween for massaging the head. The device includes a vibrator at the base of the fingers to send vibrations down the fingers to stimulate the scalp of the patient.

Blachly also teaches a device for massaging the scalp including resilient fingers 24 and a vibrator for stimulating the scalp of the patient.

Both Rabin and Blachly teach head massaging device with resilient fingers for massaging the scalp provided with vibrators to enhance the massage. It would have been obvious to one of ordinary skill in the art to modify Robbins to include a vibrator as taught by Rabin and Blachly to enhance the massaging effect on the scalp.

Regarding claims 15 and 30, the claimed transversely extending portion is merely the shape of the fingers as they exist near the handle. Robbins teaches “upon application of a force sufficient to cause bending, once bent by a user so as to be moved to another position or formed into another shape under a bending force, the flexible, metallic prongs or fingers 22, 24, 26 and 28 will stay in that shape.” Clearly Robbins teaches the fingers can be bent into any desired configuration. As the device is used the fingers would necessarily have to expand outwardly in order to accommodate the shape of the head. The ends of the fingers adjacent the handle would have to approach a transverse direction as they expand outwardly. Since Robbins teaches that the shape of the fingers can be bent in any desired position the claimed configuration would appear to be merely be a natural extension of the shape of the head. If one were to bend the fingers in a shape to best accommodate the shape of the head they would comprehend the claim language.

Claims 1, 2, 7, 15-17, 23, 26, 27 and 29 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rabin et al.

Broadly, Rabin teaches a plurality of resilient fingers 12, 30, 32 and an electric vibrator including motor 28 using an eccentric weight. As shown in figure 8, in its relaxed state the

resiliency of the fingers collapse such that the opening of the free ends of the fingers is smaller than the larger head receiving space above it. The vibrator within housing 20 is coupled to the ends of the fingers opposite the free ends of the fingers. Moreover, the opposite ends of resilient fingers 30, 32 are coupled to the housing 20 by wing nuts 16, 18. When the Rabin device is to be placed on the head of the user, the ends of the fingers 30, 32 are expanded and placed on the head of the user and as the device is pressed onto the head the ends of the fingers would apply pressure to and massage the head of the user as the device is pressed onto the head. Broadly, it would appear that Rabin anticipates the invention as claimed.

Claims 1-3, 7-10, 15-19, 23, 26-29 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Taylor.

Broadly, Taylor teaches a plurality of resilient fingers 16 and an electric vibrator 14. The electric vibrator 14 is coupled to the opposite ends of the fingers 16. As shown in figure 1, it would appear that fingers 16 help to define a head receiving space. The ends of the fingers opposite the free ends define a head receiving space there between. The free ends of the fingers are intended to be bent inwardly toward the head of the user to apply pressure and massage the head. Since the free ends of fingers 16 are intended to be bent inwardly toward the head they can be bent even further inward to define an opening that is smaller than the head receiving space. Due to the fact that the fingers are made of a material that allows the fingers the ability to bend to any position and retains the new position, one can bend the fingers such that they would define an opening that is smaller than the head receiving space. When the device is then pressed on the head of the user the free ends of the fingers 16 would contact and apply pressure to the head of the user expanding outwardly under the pressing forces to apply forces and thus massage the

head. The Taylor device is capable of conforming to the shape claimed and therefore would appear to anticipate the invention as claimed.

Claims 1, 4, 6-8, 10, 13-17, 19, 22-27, 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson in view of Rabin et al.

Erickson teaches a plurality of resilient fingers S and an electric vibrator M, 14, coupled to the opposite ends of the fingers. While it is not clear if the ends of the fingers of Erickson define an opening smaller than the head receiving space there appears to be no unobviousness to shape the fingers as desired to best conform to the shape of a person's head. If the fingers of Erickson were modified to cover more of the person's head they would then curve inwardly to accommodate the shape of the head such as taught by Rabin. Rabin teaches an equivalent head massaging device with fingers that are longer such that they curve inwardly at the ends to have the claimed shape. The Rabin device massages more of the head surface than that of Erickson. To provide a more complete coverage of the person's head one would extend the fingers down around the head with the ends curving inwardly to define an opening smaller than the larger portion of the head receiving space. The opening defined by the free ends of the fingers would be smaller than the head receiving space and therefore contact the head of the user as the device is pressed onto the head to apply pressure and thus massage the head. It would have been obvious to one of ordinary skill in the art to modify Erickson to shape the fingers to be a little longer as taught by Rabin so as to cover more of the head and massage more area.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson and Rabin et al. as applied to claim 32 above, and further in view of Rowe.

It would have been obvious to one of ordinary skill in the art to further modify Erickson to include a spherical end to the fingers as taught by Rowe to prevent injury to the skin and to allow smooth movement of the fingers over the skin.

As a result of a pending ReExamination proceeding on the parent application a new reference has come to the attention of the examiner. An Australian design patent AU-134633 was filed 12 January 1998 by appellant and became public 12 August 1998. With the filing date of the instant application being 22 August 2001 this publication is prior art. A new grounds of rejection is being applied in this examiner's answer.

Claims 1-4 and 6-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Australian design patent AU-134633 by Lacey in view of Rabin et al. or Blachly.

Since the Australian design patent is appellant's own patent on the same invention the overall design of the head massaging device has been disclosed to the public before the filing of the instant application. The design patent discloses appellant's claimed relationship of the size of the opening formed by the free ends of the resilient fingers being smaller than the head receiving space. The free ends of the fingers would apply pressure to and thus massage the head as the device is pressed on the head of the user. The design patent also discloses the fingers extending transversely adjacent the handle. The only difference is the addition of a vibrator within the handle of the device. The same explanation given above in the rejection of Robbins in view of Rabin and Blachly would apply here as well. It would have been obvious to one of ordinary skill in the art to modify Lacey to include a vibrator as taught by Rabin or Blachly to enhance the massaging treatment of the head.

(10) Response to Argument

Regarding Issue 1 Rejection of claims 1-4 and 6-33 under 35 U.S.C. §103(a) over Robbins '980 in view of Rabin '799 or Blachly '990.

Appellant argues that Robbins fails to teach the head receiving space. Appellant argues that some of the figures in Robbins depict the fingers as being bent, but there is no suggestion that this has any significance to the working of Robbins and, more particularly, that a head could be received within the space defined by the fingers. The Robbins device is intended to be used in the same manner as applicant's invention. As the device is forced over the head of the patient the fingers will expand over the head creating a head receiving space with the free ends of the fingers applying pressure to and thus massaging the head. The fingers are designed and intended to form a head receiving space there between. The free ends of the fingers as shown in figures 1

and 10 are curved inwardly toward the longitudinal center line of the device forming an opening that is smaller than the space just to the left of the free ends as depicted in figure 1. This would comprehend the claimed shape.

Appellant admits that the fingers may be bent by the user to be moved to another shape. Since the device is intended to be used in the same manner as appellant's invention the user would be bending the fingers to accommodate the shape of a particular user's head. Therefore the user would be manipulating the shape of the fingers to find the best head receiving shape for a particular individual. One would be manipulating the shape of the fingers to find the optimum head receiving space as claimed. Appellant's claimed shape is only the natural result of finding the best optimum shape for the particular individual in the prior art. There appears to be no unobviousness to find the optimum characteristics of the prior art during normal operating conditions.

Regarding appellant's arguments that Rabin does not disclose or suggest the arrangement of fingers as claimed, Rabin is not cited to teach this feature because the primary reference already teaches this. Rabin is cited to teach the convention of providing a vibrator in combination with the resilient fingers of a head massaging device.

Moreover, it is felt that in fact Rabin does teach that the claimed finger shape with the free ends of the fingers defining an opening that is smaller than the head receiving space such that the ends of the fingers would apply pressure to the head and thus massage the head. The fingers form a head receiving space as clearly shown in the drawings. Figure 8 of Rabin clearly shows how the opening of the fingers is collapsed into a smaller configuration that the larger head receiving space above the opening.

The same would apply to Blachly. Blachly is not cited to teach the free ends of the fingers forming an opening that is smaller than the head receiving space. Robbins already teaches. Blachly is another prior art reference that teaches the convention of providing a vibrator in combination with a head massaging device with resilient fingers.

Appellant argues that Robbins actually refers to Rabin '799 within the specification and insinuates that Robbins overcomes the problems in the prior art and therefore teaches away from Rabin. It is noted that the Robbins specification makes reference not to the Rabin patent 5,421,799 used in this rejection but rather refers to a design patent Des. 368,141. The design patent does not disclose the vibrator which is the purpose of citing Rabin. The intent of citing Rabin in this rejection is for the purpose of showing the convention of using a vibrator in combination with a head massaging apparatus that has resilient fingers. Robbins merely sets forth the state of the art of head massagers and suggests theirs is different from the prior art.

Regarding claims 15 and 30, as noted above, Robbins teaches that the fingers can be bent to any desired shape and the optimal shape would be one that best conformed to the shape of the head. The fingers would inherently have to be bent outwardly or transversely to the handle in order to expand out over the head. The shape to best accommodate the shape of the head would require the fingers to expand outwardly and approach the shape claimed.

Regarding Issue 2 Rejection of claims 1, 2, 7, 15-17, 23, 26, 27 and 29 under 35 U.S.C.

§102(b) over Rabin '799.

As noted above, Rabin teaches resilient fingers 12, 30, 32 that terminate in ends that contact the head of the user. Appellant states that the ends of the fingers do not contact the head of the user however admits that the resilient pads 54, 70, 72, 86, 88 contact the head of the user.

The resilient pads are at the ends of the fingers. If the ends of the fingers contact the head of the user through the resilient pads it is not clear how appellant can disregard the teaching of Rabin.

Appellant admits that the fingers of Rabin curls up on itself as shown in figure 8. In order to use the scalp massager the user physically expands the scalp massager 10, stretching the frame 12 into an arc in order to place the device on the head of the user. As the user lets go of the fingers, the resiliency of the fingers would collapse the ends of the fingers toward themselves contacting the head of the user. As the device is further pressed into place on the head of the user the free ends of the fingers would apply pressure to the head and thus massage the head. This is much the same action that occurs in the instant invention. As the user forces the device onto the head, the fingers have to physically expand the opening of the fingers, stretching the fingers over the head of the user. In both inventions, as the device is forced onto the head of the user, the opening of the ends of the fingers expand in order to receive the head of the user. The ends of the fingers contact and apply pressure to the head.

Regarding claims 1 and 23, appellant argues that Rabin doesn't teach the opposite ends of the fingers are coupled together. The portions of the fingers opposite the free ends are coupled to the main frame 20. With the free ends being the ends that engage the head, the opposite end of the fingers is that which is coupled together at the frame 20. Moreover, the free ends of fingers 30, 32 are coupled to the frame 20 by wing nuts 16, 18.

Regarding claim 15, the fingers adjacent the vibrator 20 at 12 extend transversely immediately adjacent the vibrator handle portion 20. Those portions 12 of the fingers immediately adjacent the handle 20 extend outwardly or transversely as shown in figure 1. The fact that the fingers curl up upon themselves is immaterial.

Regarding issue 3 Rejection of claims 1-3, 7-10, 15-19, 23 and 26-29 under 35

U.S.C. §102(B) over Taylor '771.

Appellant argues that Taylor does not disclose a device in which the free ends of the fingers apply pressure to and massage the head as the device is lowered onto the head with the head entering the head receiving space through an opening defined by the free ends of the fingers. As noted above, the bendable fingers 16 can be moved to a position in which the ends of the fingers define an opening that is smaller than the head receiving space as shown in figure 2. If the fingers were bent in the direction of arrow 46 to a point where the ends of the fingers were within the space that is occupied by the silhouette of the head as shown in figure 2 it would form an opening that is smaller than the head receiving opening that is between the opposite ends of the fingers. Thus when the device is lowered onto the head of the user the ends of the fingers with then contact the head of the user and continued pressure would then force the ends of the fingers outward back outside the space that is occupied by the silhouette of the head as shown in figure 2. The ends of the fingers would apply pressure to the head and thus massage the head as it is placed over the head of the user. This would appear to anticipate the invention as claimed.

Regarding claims 1 and 23, the opposite ends of the fingers are coupled together on the headset. The headset couples the fingers together to form the unitary device and broadly comprehend the claims.

Regarding claim 15, the opposite ends 43 of the fingers 16 extend transversely to the longitudinal axis of the head of the user and therefore comprehend the claims. The headset of Taylor acts as a handle for handling and manipulating the device.

**Regarding Issue 4 Rejection of claims 1, 4, 6-8, 10, 13-17, 19, 22-27 and 30-32 under
35 U.S.C. §103(a) over Erickson '444 in view of Rabin '799.**

Erickson teaches all of the claimed limitations including a head receiving space between the resilient fingers. The fingers of the device are intended to be fit over the head of the patient. Erickson may not teach the size of the opening defined by the ends of the fingers is smaller than the head receiving space however, this is merely change in the shape of the fingers. If the fingers were longer to encompass more of the head of the patient then the ends would curl unto itself forming a smaller opening much like that of Rabin. The fingers of Rabin encompass more of the head surface by extending downward toward the neck of the patient thereby forming an opening that is smaller than the head receiving space. If the fingers of Erickson were longer to extend toward the neck of the patient the fingers would then have an opening that would be smaller than the head receiving space comprehending the claim language. Robbins teaches that the fingers may be bent during use of the device to best conform the shape of the fingers to fit the head of the user. Such is well known to the artisan of ordinary skill as exemplified by Robbins.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Conclusion

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (10) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer

exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

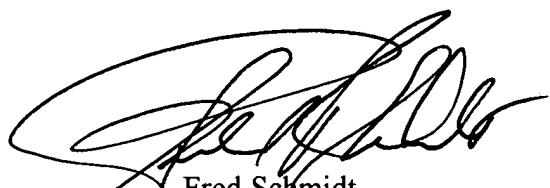
Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,



Danton DeMille
Primary Examiner

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in the section above by signing below:

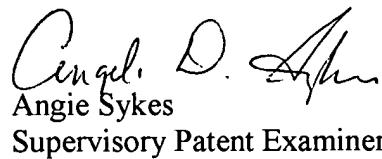


Fred Schmidt
Group 3700 Director

Conferees:



Greg Huson
Supervisory Patent Examiner



Angie Sykes
Supervisory Patent Examiner

BURR & BROWN
PO BOX 7068
SYRACUSE, NY 13261-7068